

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Re: Appeal to the Board of Patent Appeals and Interferences

Appellants: Wojcik et al.)	Examiner: Scott J. Haughland
)	
Serial Number: 10/085,813)	Group Art Unit: 3654
)	
Filed: February 28, 2002)	Customer Number: 22827
)	
Confirmation No: 2378)	Deposit Account: 04-1403
)	
Title: Center/Surface Rewinder and Winder)	Attorney Docket No: KCX-450 (16960)
)	

1. ☐ **NOTICE OF APPEAL:** Pursuant to 37 CFR 41.31, Applicant hereby appeals to the Board of Appeals and interferences from the last decision of the Examiner.
2. ☐ **PRE-APPEAL BRIEF REQUEST FOR REVIEW:** Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reason(s) stated on the attached sheet(s) [No more than five (5) pages may be provided.]
3. ☐ **BRIEF** on appeal in this application pursuant to 37 CFR 41.37 is transmitted herewith (1 copy).
4. ☐ An **ORAL HEARING** is respectfully requested under 37 CFR 41.47 (due within two months after Examiner's Answer).
5. ☒ Reply Brief under 37 CFR 41.41(b) is transmitted herewith (1 copy).
6. ☐ "Small entity" verified statement filed: [] herewith [] previously.

7. **FEE CALCULATION:**

	Fees
If box 1 above is X'd enter \$ 540.00	\$ <u>0.00</u>
If box 2 above is X'd enter \$ 0.00 (no fee)	\$ <u>0.00</u>
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PETITION is hereby made to extend the original due date of June 30, 2009, hereby made for an extension to cover the date this response is filed for which the requisite fee is enclosed (1 month \$130; 2 months \$490; 3 months \$1,110; 4 months \$1,730, 5 months \$2,350) \$ 0.00

SUBTOTAL: \$ 0.00

Less any previous extension fee paid since above original due date. - \$ 0.00

Less any previous fee paid for prior Notice of Appeal since Board did not render a decision on the merits. MPEP § 1204.01 - \$ 0.00

Less any previous fee paid for submitting Brief on prior Appeal since

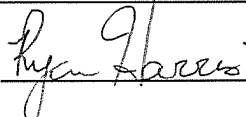
Board did not render a decision on the merits. MPEP § 1204.01 - \$ 0.00**SUBTOTAL:** \$ 0.00If "small entity" verified statement filed ☐ previously,☐ herewith, enter one-half (½) of subtotal and subtract - \$ 0.00**TOTAL FEE ENCLOSED:** \$ 0.00☐ Fee enclosed.☐ Charge fee to our Deposit Account/Order Nos. in the heading hereof (for which purpose one additional copy of this sheet is attached)☒ Charge to credit card (attach Credit Card Payment Form – PTO 2038)☐ Fee NOT required since paid in prior appeal in which the Board of Appeals did not render a decision on the merits.

The Commissioner is hereby authorized to charge any fee specifically authorized hereafter, or any fees in addition to the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (deficiency only) now or hereafter relative to this application and the resulting official document under Rule 20, or credit any overpayment, to our Account No. shown in the heading hereof. This statement does not authorize charge of the issue fee in this case.

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I hereby certify that this correspondence and all attachments and any fee(s) are being electronically transmitted via the internet to the U.S. Patent and Trademark Office using the Electronic Patent Filing System on May 28, 2009.

Sandra S. Perkins

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(Signature of person transmitting documents)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Winder)	
)	Customer No: 22827

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF TO EXAMINER'S ANSWER

Appellants submit the following reply brief in accordance with 37 C.F.R. § 41.41:

1. REAL PARTY IN INTEREST

See Appellants' Brief on Appeal.

2. RELATED APPEALS AND INTERFERENCES

See Appellants' Brief on Appeal.

3. STATUS OF CLAIMS

See Appellants' Brief on Appeal.

4. STATUS OF AMENDMENTS

See Appellants' Brief on Appeal.

5. SUMMARY OF CLAIMED SUBJECT MATTER

See Appellants' Brief on Appeal.

6. GROUND S OF REJECTION TO BE REVIEWED ON APPEAL

See Appellants' Brief on Appeal.

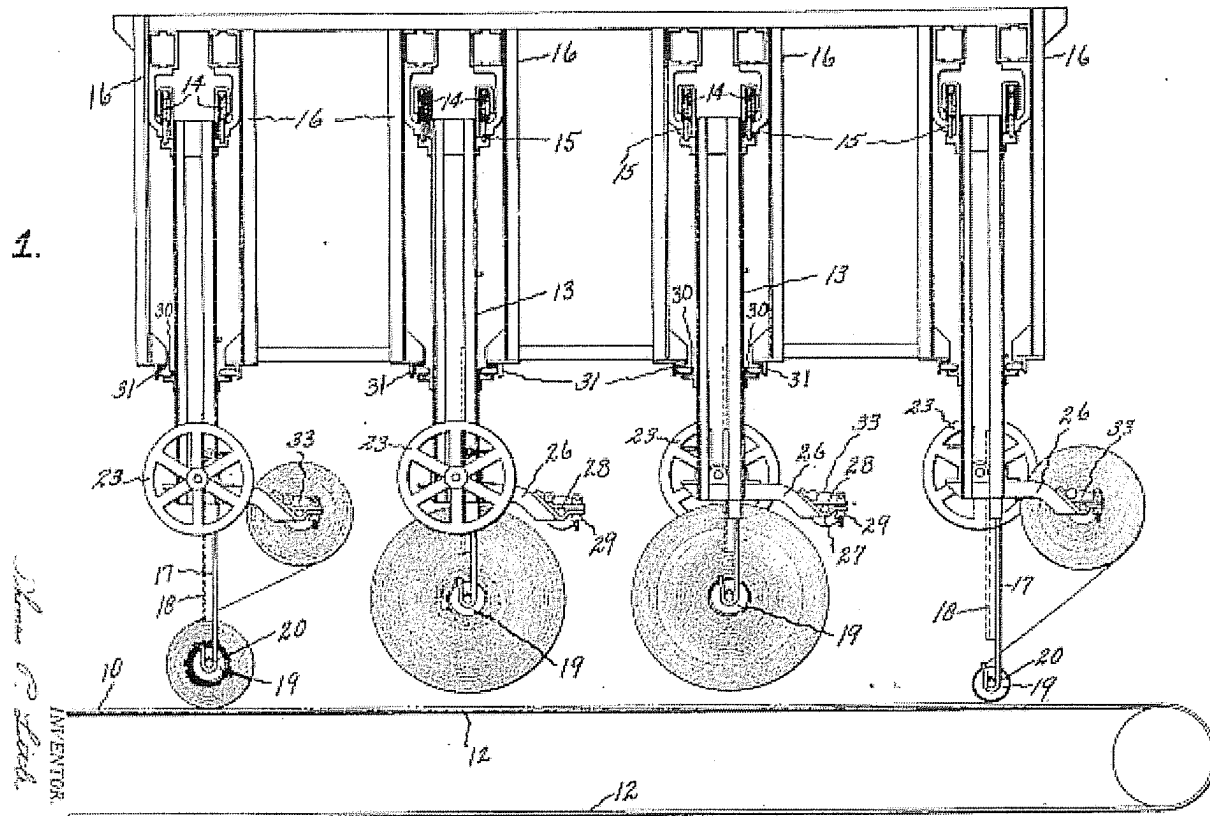
7. ARGUMENT

See Appellants' Brief on Appeal.

Response to Examiner's Answer

- I. **Claims 71-75, 77, 83, 84, 87, 90-99, 101, 103-106 and 108-115 are patentable over Little in combination with Nistri and Kammann.**
 - A. **Independent claim 71 is patentable over Little, in proper combination with Nistri et al. and Kammann.**
 - 1. **Little teaches away from mandrels extending across the web transport apparatus.**

In response to Appellants' arguments presented under heading I.A.1, the Examiner states that "Little does not disclose any problem that would discourage an ordinary artisan . . . from making the mandrels extend from one side of the winding apparatus to the other side." Appellants disagree. Little clearly discloses that the "belt is wide enough to carry two rubber strips side by side, in consequence the wind-up devices are made in two sets." Fig. 1 illustrates this:

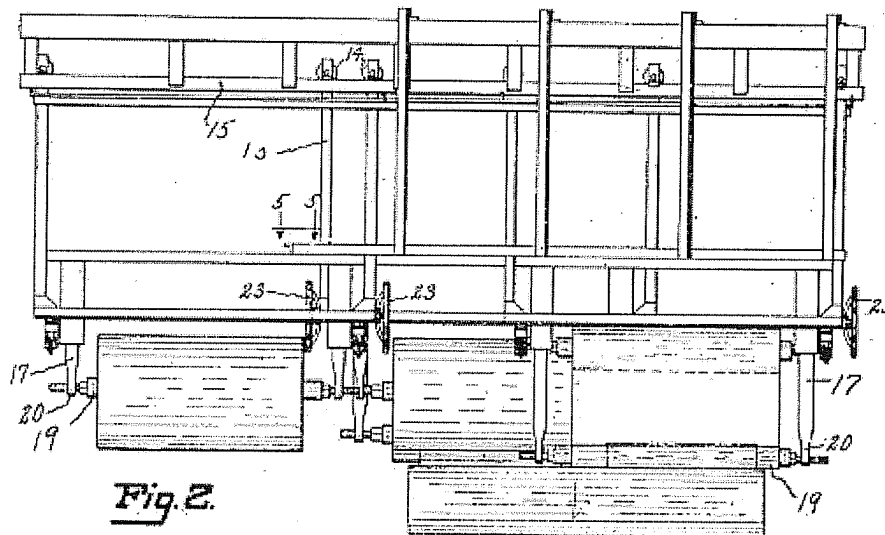


Thus, with the four winders, two are located generally on the right side of the belt and two are located generally on the left side of the belt. When the first roll of each pair is complete, "the rubber strip is cut and started around the other wind-up roll of the pair." Pg. 1, lines 101-102. The full roll is then moved out of the range of the belt and replaced and readied for completion of the other roll in the pair. Pg. 1, line 101 – pg. 2, line 5.

Little contains **two sets** of the winders (one set for the right side of the belt and one set for the left side of the belt) which allows for winding of **two strips** of rubber at once. Thus, as noted in the Brief, if the mandrel were to extend across the entire belt, **both** rubber strips would necessarily be rolled at the same time on the same winder. The Examiner's Answer notes that "the first mandrel winds one strip of material while

the other strip of material is carried by the belt past the first mandrel to the second mandrel and wound thereon." However, if the mandrels were extended across the length of the belt, the second strip could not pass the first mandrel without coming into contact. As noted in Little, "the weight of the roll resting on the stock will cause the roll to turn and the stock to be wound up." Pg. 1, lines 89-91.

Additionally, the Examiner's Answer states that the "rolls are note even disclosed as being centered in Little (see Fig. 2)." Fig. 2 is reproduced below:



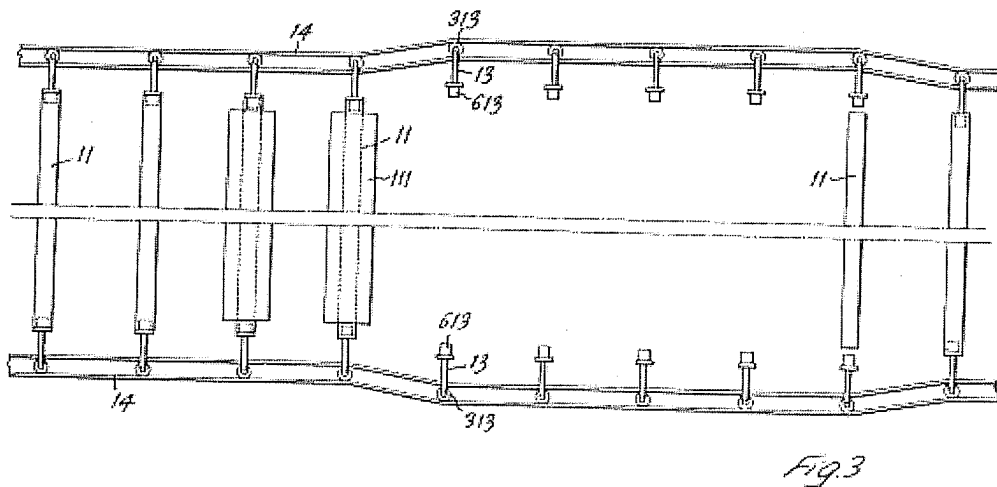
Appellants are unclear what the quoted statement above from the Examiner's Answer is intended to address. The rolls are not centered because there are two sets of rolls on each side of the belt. Fig. 2 illustrates a strip of rubber being wound on the right side of the belt, while a completed roll is being removed to the left of the belt.

Finally, the Examiner's Answer states that "the lengths of the mandrels in Little are more than half of the width of the conveyor belt and are wider than the strips of material to be wound." While it does appear that the mandrels are slightly larger than half of the belt (Fig. 2), as illustrated in Fig. 1, the winders are staggered along the belt

(i.e., there are not two mandrels directly side-by-side). This allows the rubber stock travelling the belt on the left side to pass the mandrel on the right without contact and reach its' dedicated mandrel of the other pair (on the left side of the belt) for winding. Again, a mandrel that extends the entire width of the belt would wind both strips and defeat the purpose of the two sets of winders for rolling two strips at once.

2. Nistri et al. fails to disclose mandrels extending across the web transport apparatus as alleged in the Office Action.

In response to Appellants' arguments presented under heading I.A.2, the Examiner states that "the roll supports or mandrels formed by 11, 13, and 613 (Fig. 3) in Nistri et al do extend from a first side to a second side of the web transport apparatus and suggest forming the mandrels in Little to extend the full width of the belt and web transport apparatus." Appellants disagree. Fig. 3 of Nistri et al. is illustrated below:



As described by Nistri et al., the winding station includes "cardboard core **11** supported by two **mandrels 13**." Col. 4, lines 26-27. Thus, at least the "mandrels" of Nistri et al. do not extend across the length of the belt. Furthermore, as clearly described by Appellants in the specification, Appellants' claim single mandrels that extend the width of the belt and each mandrel is fitted with a core thereon. Such construction is

beneficial for, for instance, the abundance of other claimed features of the present invention (e.g., see claims 72-74, 77-80, 82, and 85-90).

3. Modifying Little with the driving device of Kammann renders Little unsatisfactory for its intended purpose.

In response to Appellants' arguments presented under heading I.A.3, the Examiner states that "there would be no reason to think that Kammann or Little as modified by Kammann would have the problems described by appellants." As noted in the Examiner's Answer, the combination is proposed as "it would have been obvious to provide Little with a driving device for center driving the mandrel as taught by Kammann to provide greater control over the winding process to permit improved winding of different webs." Pg. 5, lines 1-3. The purpose of Appellants' arguments in the Brief are to illustrate that one can not simply retrofit the winding motor of Kammann onto the apparatus of Little. A simple comparison of the two processes illustrates this:

Fig. 1 of Little:

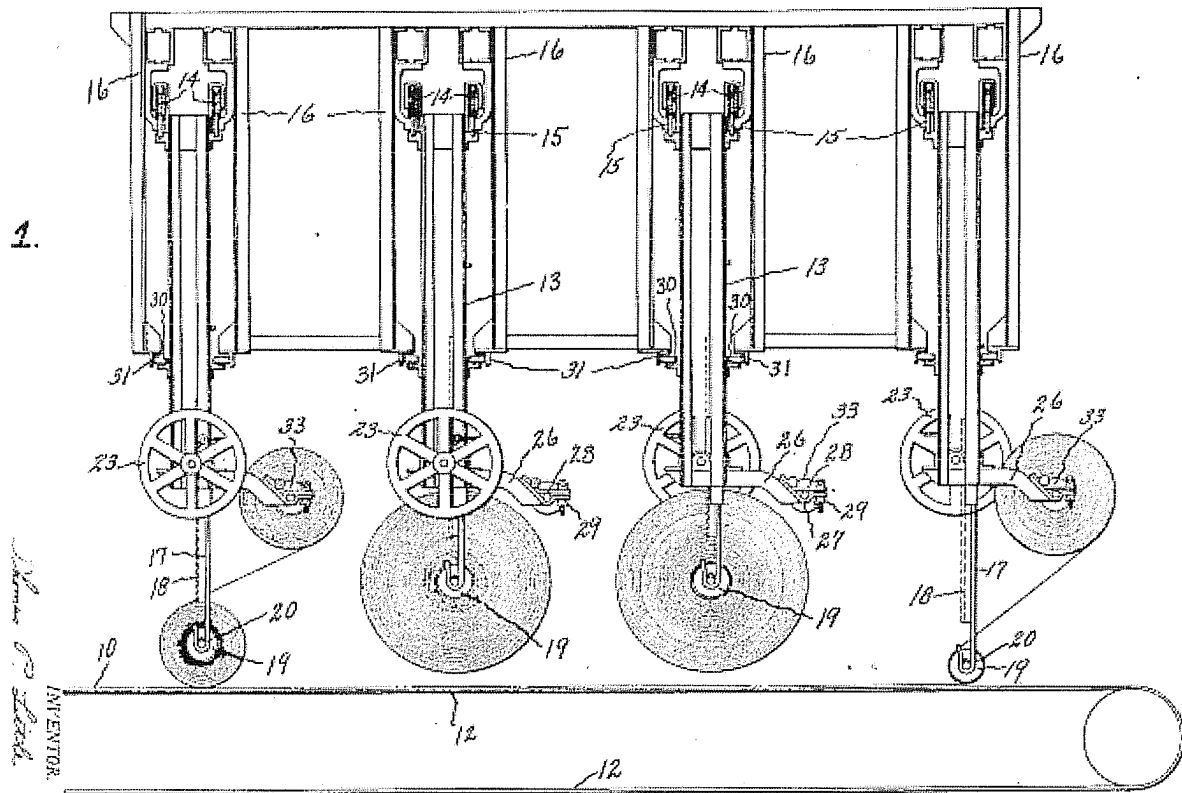
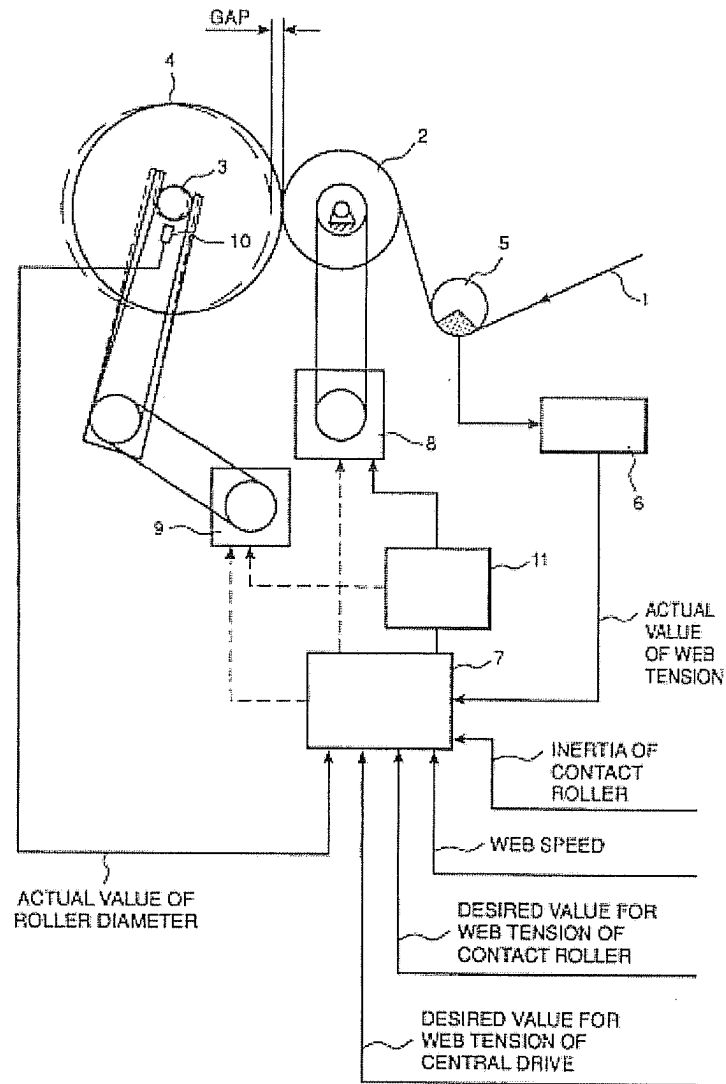


Fig. 2 of Kammann:

Fig. 2



Strictly speaking, if the hook-like formation **20** of Little were replaced “with a driving device for center driving the mandrel as taught by Kammann” as proposed by the Examiner's Answer, the roll will no longer be permitted to move slightly as the thickness of the material on the roll increases.

4. Little teaches away from center driven mandrels.

In response to Appellants' arguments presented under heading I.A.4, the Examiner states that "lack of disclosure is not the same as teaching against." Appellants note that a "prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." W.L. Gore & Associates v Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Little is directed to a wind-up device for **rubber** stock. In addition to the rubber, Little also requires a liner to be rolled onto the core (see element 33 in Fig. 1 above). Little teaches the liner and the rubber are rolled by the speed of the belt and the roll resting on the stock. One skilled in the art would be lead away from providing a center drive for rolling.

Additionally, the Examiner's Answer states, "Kammann teaches adding a center drive (mandrel drive) in order to allow for the satisfactory winding of a greater variety of webs . . ." While true, Little is not directed to winding of webs. Little is directed to **rubber** stock winding. One skilled in the art readily appreciates that rubber stock is wholly different than tissue webs. For instance, the "central gap winding" of Kammann that utilizes the center drive would clearly not be as beneficial for rubber stock. As taught by Kammann, "this mode of operation (central gap winding) is always preferred when highly sensitive films must be wound, which run the risk of being damaged by contact pressure from the contact roller." Col. 2, lines 24-27. One skilled in the art appreciates that rubber stock is not necessarily a "highly sensitive film."

B. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 74.

In response to Appellants' arguments presented under heading I.B, the Examiner states that "this is disclosed by all three references. It is the basis of their operation." However, Appellants respectfully submit that no reference discloses a capability of **varying** the distance between the mandrel and the web transport apparatus to control a nip pressure to a desired amount. "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

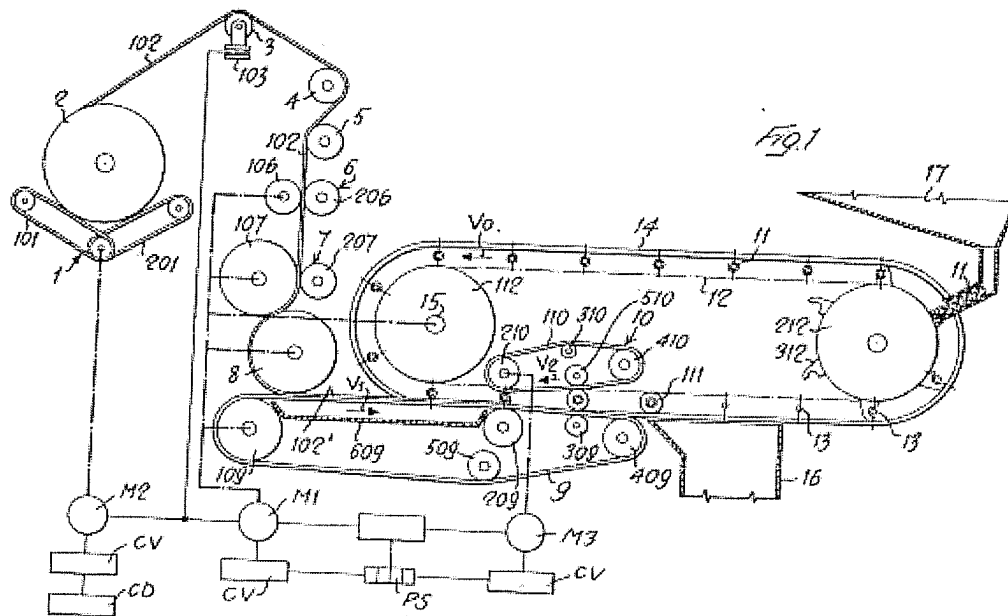
C. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 77.

In response to Appellants' arguments presented under heading I.C, the Examiner states that "Little discloses apparatus for loading cores and unloading rolls (note the trolley including wheels 14 and rails 15 in Fig. 2). Appellants fail to see any disclosure in Little that indicates that the winding modules incorporate both a core loading and product stripping apparatus. Little teaches:

The frame 13, carrying the full roll, is now moved sideways out of the range of the belt, the full roll replaced by an empty one, and the empty liner spool replaced by a full one. Pg. 1, line 104 – pg. 2, line 2.

Clearly, there is no teaching that **the winding modules** comprise a core loading and product stripping apparatus as described and claimed by Appellants. Interestingly, the Examiner seemingly agrees with Appellants in the "Grounds of Rejection" section of the Examiner's Answer that states "Little does not disclose a core loading or product stripping apparatus." Pg. 8, line 18.

Additionally, the Examiner states, "Nistri et al also teaches these features." Appellants respectfully disagree. Fig. 1 of Nistri et al. is reproduced below:



The Examiner points to element 17 as a core loading apparatus and element 16 as a product stripping apparatus. Regarding the “core loading apparatus,” Nistri et al. teaches that the mandrels are advanced “to the feeding station 17 where the new cores 11 are supplied therebetween. At this station the cores 11 are picked up by one of the hooks 312 . . .” Col. 4, lines 51+. However, Appellants note that claim 77 requires that the winding modules include a core loading and product stripping apparatus. Clearly the winding modules (i.e., element 13 of Nistri et al.) do not include both a core loading and product stripping apparatus as described and claimed by Appellants.

D. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 83.

In response to Appellants’ arguments presented under heading I.D, the Examiner states that “Little as modified, if not the disclosure of Little, includes the subject matter of claim 83. Also note Nistri et al.” First, Appellants submit that Little can not be modified in the manner suggested for reasons of record. Second, the disclosure of Little

indicates mandrels located at different positions along the belt (i.e., not in a linear arrangement with respect to one another along the web transport apparatus). Third, Nistri et al. does not disclose a "plurality of winding modules are located in a substantially linear arrangement with respect to one another along the web transport apparatus" (emphasis added) as required by claim 83. Indeed, the winding modules (element 13) are positioned in a continuous loop belt positioned away from any apparatus that could be considered a web transport apparatus as described and claimed by Appellants.

E. Independent claim 91 is patentable over Little, in proper combination with Nistri et al. and Kammann.

1. **Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest accelerating one of the mandrels to a desired rotation speed and positioning the rotating mandrel adjacent to the conveyor belt for forming a nip between the web transport apparatus and the mandrel.**

In response to Appellants' arguments presented under heading I.E.1, the Examiner states that "acceleration of the mandrel is inherent or implicit in all of the applied references. For example, the mandrels are clearly not rotating when loaded onto supports and do rotate when contacting moving web on the conveyer belts, thus requiring acceleration." Appellants note that independent claim 91 requires:

accelerating one of the mandrels to a desired rotation speed;
positioning the rotating mandrel adjacent to the conveyor belt for forming a nip between the web transport apparatus and the mandrel.

Thus, independent claim 91 requires one of the mandrels to be accelerated prior to forming the nip as the rotating mandrel is positioned adjacent to the conveyor belt. In

stark contrast, "all of the applied references" utilize friction rolling when a nip is formed (i.e., the mandrel is not accelerated prior to forming the nip). Kammann discloses an apparatus capable of accelerating a mandrel, but it is only utilized in "central gap winding" in which a nip is not formed adjacent the conveyor belt. Appellants note that "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

2. Little teaches away from mandrels extending across the web transport apparatus.
3. Nistri et al. fails to disclose mandrels extending across the web transport apparatus as alleged in the Office Action.
4. Modifying Little with the driving device of Kammann renders Little unsatisfactory for its intended purpose.
5. Little teaches away from center driven mandrels.

The Examiner offers no further rebuttal to Appellants arguments under headings I.E.2 – I.E.5.

F. Claim 93 is patentable over Little in proper combination with Nistri et al. and Kammann.

1. Modifying Little with the mandrels of Nistri et al. and slitting the web to permit the simultaneous winding of webs of various widths in Little renders Little unsatisfactory for its intended purpose.

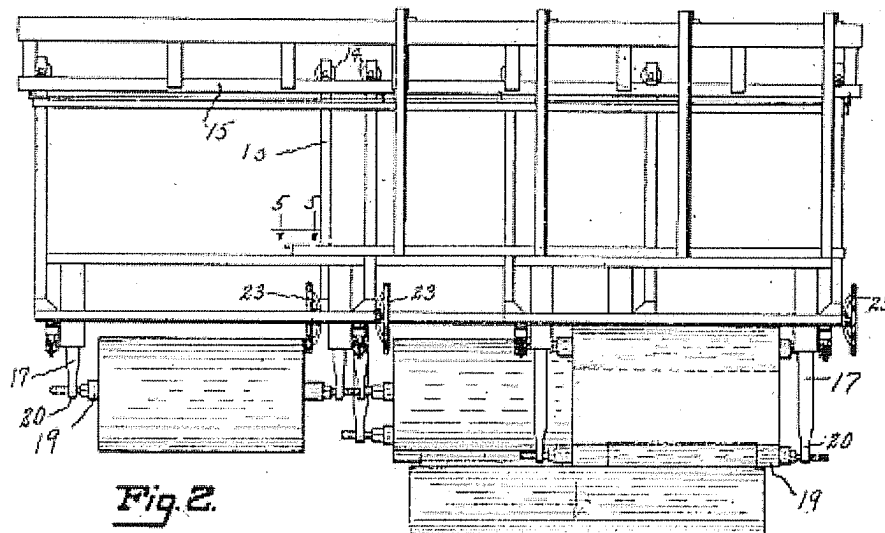
In response to Appellants' arguments presented under heading I.F.1, the Examiner states that "Little discloses slitting of the web." Appellants note that claim 93 requires that the process further comprises "the steps of slitting the tissue web as the web is unwound to form a first slit and a second slit and feeding each slit to a separate set of consecutively positioned winding modules along the reel transport apparatus."

Little fails to disclose such a limitation. Little discloses that two **rubber** strips may be carried side-by-side along the belt, but there is certainly no process disclosed wherein an apparatus slits the web as it is unwound and feeds each slit to separate winding modules as disclosed and claimed by Appellants.

Additionally, the Examiner goes on to repeat his argument that:

The mandrels in Little are more than one half of the width of the belt and are wider than the strips of material to be wound. The first mandrel overlies portions of both strips. Only one strip is attached to each mandrel to initiate winding thereon. Making the mandrels in Little the full width of the conveyor belt would not change the operation of the winder for winding slit webs.

Appellants are unclear as to how such a claim has materialized. Fig. 2 of Little is illustrated below:



As Illustrated, the mandrel on the right is winding a liner and the rubber stock (the rubber stock is the smaller material centered on the mandrel). The other rubber stock strip is not illustrated as the left roll is in "mid-wind" and the liner blocks the view of the rubber. However, simple comparison of the size of the rubber stock on the right with the width of the belt illustrates that the second rubber stock strip clearly is not overlapped by

the mandrel (element 19) as alleged by the Examiner. Indeed, if the Examiner's assertions were true, it would not be necessary for Little to stagger the wind-up devices in the manner described.

G. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 94.

In response to Appellants' arguments presented under heading I.G, the Examiner states that "controlling the position and speed of the winding module to produce a rolled product with desired characteristics is implicit or explicit in the applied references. The other limitations of the claim have been addressed above." Similar to Appellants rebuttal arguments above pertaining to claim 91, no reference discloses accelerating the mandrel and then positioning the winding module to initiate contact between the rotating core and the web. Appellants note that "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

H. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 95.

In response to Appellants' arguments presented under heading I.H, the Examiner states that "Little discloses winding by surface winding only." While true, Appellants note that independent claim 91 (which claim 95 depends from) requires accelerating the mandrel and then positioning the mandrel adjacent to the belt. Claim 95 further limits claim 91 and requires that "after winding is initiated, winding is continued only by surface winding such that the mandrel is positioned towards the web transport

apparatus at a controllable magnitude to create a nip pressure to control winding of the web." No reference teaches or suggests this combination of process steps.

I. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 97.

In response to Appellants' arguments presented under heading I.I, the Examiner states that "Kammann teaches combined center and surface winding." Appellants note that claim 97 requires that "wherein after winding is initiated, further winding is carried out by using a combination of center winding and surface winding, center winding occurring by driving the mandrel and surface winding occurring by positioning the mandrel towards the web transport apparatus at a controllable magnitude to create a nip pressure to control winding of the web." Kammann teaches two modes of operation independent of each other. Kammann notes that the device may be switched from one mode to the other, but not operated simultaneously. Col. 4, lines 10-15.

J. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 98.

In response to Appellants' arguments presented under heading I.J, the Examiner states that "Nistri et al teaches stripping a wound roll from a mandrel." In lieu of the Examiner's arguments and upon further inspection of Nistri et al., Appellants respectfully withdraw the arguments presented in the Brief under heading I.J. Appellants submit that claim 98 is at least patentable for all the other reasons noted regarding independent claim 91.

K. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 103.

In response to Appellants' arguments presented under heading I.K, the Examiner states that "Nistri et al teaches loading cores on mandrels and removing wound rolls." In lieu of the Examiner's arguments and upon further inspection of Nistri et al., Appellants respectfully withdraw the arguments presented in the Brief under heading I.K. Appellants submit that claim 103 is at least patentable for all the other reasons noted regarding independent claim 91.

L. Claim 104 is patentable over Little in proper combination with Nistri et al. and Kammann.

In response to Appellants' arguments presented under heading I.L, the Examiner states that "the unloading of rolls is substantially simultaneous with the loading of empty mandrels in Little as disclosed." Appellants note that claim 104 requires that "the plurality of winding modules include at least three winding modules that are positioned adjacent to the web transport apparatus and wherein during the process at substantially the same time, a core is loaded on a first mandrel of a first winding module, a roll of material is formed on a second mandrel of a second winding module, and a wound roll is stripped from a third mandrel of a third winding module." While Little may disclose unloading a wound roll (manually) while a roll is being formed on a different mandrel, Little does not disclose three mandrels where, **at substantially the same time**, a core is being loaded on one mandrel, material is formed on a second mandrel, and a wound roll is stripped from a third mandrel.

M. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 106.

In response to Appellants' arguments presented under heading I.M, the Examiner states that "the claimed process fault does not distinguish over the completion

of a wound roll in Nistri et al." As noted in the MPEP at § 2111, "(t)he Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest **reasonable** construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed. Cir. 2004). Appellants respectfully submit that, in light of the specification, no **reasonable** claim construction could yield that a process **fault** would include successful completion of a rolled product.

N. Claim 108 is patentable over Little in proper combination with Nistri et al. and Kammann.

In response to Appellants' arguments presented under heading I.N, the Examiner states that "duplication of parts to increase capacity and efficiency would have been obvious to an ordinary artisan." Appellants submit that claim 108 is patentable for the additional reasons as claim 93 (section I.F. above). Appellants respectfully disagree with the Examiner's "duplication of parts" assertion. One skilled in the art would not look to the disclosures of Little, Nistri et al., and Kammann and determine that forming more than two slits from a parent roll to feed to more than two mandrels would be considered an obvious "duplication of parts." The parts are not "merely duplicated" but require a non-obvious refined process in order to accomplish Appellants' disclosed and claimed limitations.

O. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 109.

In response to Appellants' arguments presented under heading I.O, the Examiner attempts to proffer reasons for which the claimed limitation of "the step of accelerating

the mandrel to a rotation speed that substantially matches the speed of the conveyor belt prior to forming the nip between the web transport apparatus and the mandrel.”

The Examiner states, “in the apparatus of Little as modified by Kammann, initially accelerating the mandrel/web in the non-surface driving mode . . . and thereafter switching to a surface driving mode in which the belt contacts the mandrel/web roll reads on the limitations of claim 109.” Kammann does not disclose utilizing “central gap winding” and, in the middle of operation, switching to “central contact winding.”

Furthermore, such a function would not be obvious to one skilled in the art in light of the disclosure of Kammann. Indeed, Kammann teaches that “this mode of operation (central gap winding) is always preferred when highly sensitive films must be wound, which run the risk of being damaged by contact pressure from the contact roller.” Col. 2, lines 24-27. Clearly, one skilled in the art wouldn’t begin utilizing “central gap winding” and “throw the switch” to “central contact winding” (if that were even possible). Indeed, there is no teaching or suggestion in any reference to obviate what the Examiner has proposed as the reasons that claim 109 is “obvious.” Plainly, modification of the references in such a manner results from using Appellant’s disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art, which is improper under 35 U.S.C. § 103. Accordingly, it is respectfully submitted that any such modification of the cited references relies on the impermissible use of hindsight, which cannot be successfully used to support a *prima facie* case of obviousness.

P. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 110.

In response to Appellants' arguments presented under heading I.P, the Examiner states, "all of the applied references disclose the recited limitations." Appellants disagree. No reference teaches the ability to utilize a positioning apparatus to adjust and control the nip pressure. Little and Nistri et al. teach surface winding with no means to adjust and control the nip pressure. Kammann teaches surface winding and teaches "central gap winding" in which there is a gap (not a nip).

Q. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 113.

R. Little, in proper combination with Nistri et al. and Kammann, fails to teach or suggest the additional limitations of dependent claim 114.

In response to Appellants' arguments presented under headings I.Q and I.R, the Examiner states, "the claimed process fault does not distinguish over the completion of a wound roll in Nistri et al." Appellants restate their rebuttal arguments as noted above in section I.M. No reasonable claim construction would encompass what the Examiner contends.

VII. Claims 82, 85, and 86 are patentable over Little in combination with Nistri et al. and Kammann and Dusenbery.

A. Claim 82 is patentable over Little in proper combination with Nistri et al. and Kammann and Dusenbery.

1. The Examiner improperly combines the teachings of Dusenbery with Little by incorporating the loading apparatus of Dusenbery as proposed by the Office Action.

B. Claim 85 is patentable over Little in proper combination with Nistri et al. and Kammann and Dusenbery.

1. The Examiner improperly combines the teachings of Dusenbery with Little by incorporating the product

stripping apparatus of Dusenbery as proposed by the Office Action.

C. Claim 86 is patentable over Little in proper combination with Nistri et al. and Kammann and Dusenbery.

1. The Examiner improperly combines the teachings of Dusenbery with Little by incorporating the core loading and product stripping apparatus of Dusenbery as proposed by the Office Action.

In response to Appellants' arguments presented under headings VII.A.1, VII.B.1, and VII.C.1, the Examiner states, "a turret is not required." Appellants respectfully disagree. Dusenbery discloses rotating the mandrels to winding, loading, and unloading stations respectively. These stations are uniquely equipped to perform the desired functions. One skilled in the art would not glean from Dusenbery the required teaching of automatically unloading and loading cores in a manner that could be "retrofitted" onto the combination of Little, Nistri et al., and Kammann as alleged by the Examiner.

Further, Appellants note that the appropriate test under 35 U.S.C. §103(a) is not whether the differences between the prior art and the claims are obvious, but instead whether the claimed invention as a whole would have been obvious. That is, the differences between a particular claim and the cited references cannot be viewed in a vacuum. In this case, Appellant respectfully submits that, when properly viewed as a whole, there is simply no incentive to one of skill in the art to combine the references in the manner suggested in the Office Action.

• General rebuttal argument

As noted above, Appellants object to numerous combinations that the Examiner has purported to be "obvious" variants of the combination of the prior art. Appellants respectfully submit that the numerous objections raised by Appellants is a result of

attempting to “shoehorn” a § 103 rejection on each claim. In doing so, Appellants’ respectfully submit that the Examiner has failed to enable **any** of the purported combinations. In merely stating “it would be obvious to combine,” the Examiner has failed to indicate **how** such combinations could effectively yield Appellants’ disclosed and claimed invention. A conclusion of obviousness requires that the references relied upon be enabling in that it put the public in possession of the claimed invention. See In re Hoeksema, 399 F.2d 269, 274 (CCPA 1968). Appellants respectfully submit that the “picking and choosing” of prior art components attempted by the Examiner results in combinations that are non-obvious and certainly would not be enabling in the sense that the public would be in possession of Appellants’ claimed invention.

VIII. The rejection of claims 71-106 and 108-116 on the ground of nonstatutory obviousness-type double patenting should be withdrawn.

In response to Appellants’ arguments presented under heading VIII, the Examiner states that “terminal disclaimers in all or all but one of the applications would be required to overcome the rejection as stated in the cited section of the MPEP. The cited MPEP section is repeated here for convenience:

If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. MPEP § 804 (I)(B)(1).

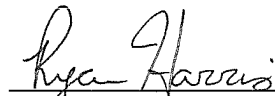
Co-pending Application No. 11/931,066 is a later-filed application and is presently rejectable on other grounds. Co-pending Application No. 11/799,043 is a later-filed application and is currently docketed for examination. Co-pending Application No. 11/930,977 is a later-filed application and is currently docketed for examination.

Upon a favorable decision with regard to patentability under §103 from the Board, Appellants agree to submit terminal disclaimers for each later-filed application that is not rejectable on other grounds (if any).

In conclusion, Appellants request favorable action and allowance of the presently pending claims.

Respectfully requested,

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Date: May 28, 2009

8. **CLAIMS APPENDIX**

See Appellants' Brief on Appeal.

9. **EVIDENCE APPENDIX**

None

10. **RELATED PROCEEDINGS APPENDIX**

None